

REMARKS

Reconsideration of this application is respectfully requested. Claims 1-5 are presently pending. Applicants have amended claim 5 to make it conform with conventional U.S. claim format. No new matter has been added by this amendment.

The Examiner restricted the present application under 35 U.S.C. § 121 to the following categories allegedly defining patentably distinct inventions:

Group I: claims 1-2 and 4, drawn to compounds and compositions;

Group II: claim 3, drawn to a process of making the compounds: and

Group III: claim 5, drawn to a method of treating dermatoses.

The Examiner also required applicants to elect a single disclosed species for prosecution on the merits should applicants elect either of Groups I or II. Finally, the Examiner indicated that since claim 6 was drawn to a nonstatutory class of invention, it was not placed in any of the above groupings.

Applicants elect, with traverse, the claims of Group I, claims 1-2 and 4, and the compound of Example 6 (prednisolone 17-n-butyrate 21-(3)-phenylpropionate) as the elected species. Although the Examiner has alleged that the inventions of Groups I-III define patentably distinct subject matter, she has not shown that it would be a serious or under burden to examine these inventions in a single application. M.P.E.P. §803. At a minimum, a complete search of the compounds of Group I should also include a search of the disclosed utility, i.e., the method of use recited in the claim of Group III. Moreover, since a disclosure of the active compounds of Group I will likely include a disclosure of their pharmaceutical utility, little burden exists in examining the claims of Group I and III together. Accordingly, applicants

LAW OFFICES

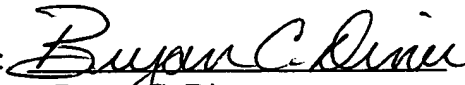
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000

request the Examiner to reconsider the restriction requirement and, at the very least, examine the inventions of Groups I and III together in this application.

Applicants await an action on the merits. If there are any fees due in connection with the filing of this paper not accounted for, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER

By: 
Bryan C. Diner
Reg. No. 32,409

Dated: April 21, 1995

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
1300 I STREET, N. W.
WASHINGTON, DC 20005
202-408-4000